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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,181	08/21/2003	Hiroshi Satomi	03500.014419.1	7320
5514 7590 03/31/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER DANNEMAN, PAUL				
ART UNIT		PAPER NUMBER		
3627				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/645,181

**Applicant(s)**

SATOMI ET AL.

**Examiner**

PAUL DANNEMAN

**Art Unit**

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 418 and 419 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 418 and 419 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Response to Amendment**

1. Claims 385-386, 389, 391-393, 401 and 409 have been cancelled.
2. Newly added Claims 418 and 419 are pending and have been examined in this application.

**Response to Arguments**

3. Arguments are rendered moot based on the cancellation of the previously pending claims.

***Specification***

4. The abstract of the disclosure is objected to because it is directed to the process of reducing the cost of printing of some information by including advertisements which compensate the user requesting the print job by including advertisements on each page printed. The invention is now directed to a process described in the industry as "automatic paste-up." Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 103***

5. **Claims 418 and 419** are rejected under 35 U.S.C. 103(a) as being unpatentable over Johari et al., US 5,911,146 in view of Chew.
6. **Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

**Claim 418:**

With regard to the limitation for an advertiser apparatus comprised of:

- ***A memory which stores a first computer program;***
- ***A processor that executes the first computer program stored in memory;***

Johari in at least Fig.2 and Column 3, lines 23-42 discloses a computer system with a central processing unit, a memory connected to the CPU and other type of storage devices which executes a set of predefined steps to carry out the invention as taught by Chew. It would have been obvious, at the time of the invention; to one of ordinary skill to combine the well known features of Johari with the well know automatic layout features of Chew with the motivation to maximize the revenue from advertisements by optimizing the layout process through automation.

- ***A first computer program that inputs an advertisement size of the advertisement data;***
- ***Transmitting the advertisement data and the input advertisement size to the information control apparatus;***

Chew in at least P8 discloses a rectangular advertisement with a defined (specified) width and height. An advertiser who wants to place an ad will reserve a space through an ad booking system called AdNet. Figure 2 discloses the overall architecture of the invention using a high-speed digital graphics / datalink.

- ***A Information apparatus comprised of:***
- ***A memory which stores a second computer program;***
- ***A processor that executes the second computer program stored in memory;***

Johari in at least Column 3, lines 40-42 further discloses that information about the pages may be outputted to another system to perform the actual layout. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to know that the system doing the actual layout is as disclosed in Fig.2 (a computer system).

- ***Receiving a designation of a print sheet size and the output information;***

- ***Determining a layout which corresponds to a type of the output information designated in the receiving step to secure an advertisement area on the determined layout;***
- ***Selecting the advertisement data having a size corresponding to the size of the advertisement area secured in said layout determining step.***

Chew in at least Figure 1, P8, P9, P10 discloses the advertisements with the defined (specified) width and height being submitted and their size being compared to the booked size, trimmed to exact size and waxed. Chew does not specifically disclose the print sheet size per se; however in at least P11-P13 discloses the manual process of finding a suitable placement for every ad with the designated ad pages. Chew in at least P17-P18 discloses the automation of the manual workflow for the automatic placement (layout) of advertisements. It would have obvious, at the time of the invention to one of ordinary skill to modify the combination of Johari/Chew with the print sheet size with the motivation to allow a print job requester to view their advertisements at the appropriate size.

**Claim 419:**

With regard to the limitation of the image forming system of Claim 418:

- ***Wherein first computer program indicates a position on the print sheet for the advertisement data and transmit the position information in the advertisement data transmitting step,***

Chew in at least P8 discloses a rectangular advertisement with a defined (specified) width and height. An advertiser who wants to place an ad will reserve a space through an ad booking system called AdNet. Figure 2 discloses the overall architecture of the invention using a high-speed digital graphics / datalink for transmission.

- ***Wherein second computer program in the information control apparatus selects the advertisement data which has the position information indicating the position corresponding to the advertisement data.***

Johari in at least Column 3, lines 40-42 further discloses that information about the pages may be outputted to another system to perform the actual layout. Chew in at least Figure 1, P8, P9, P10 discloses the advertisements with the defined (specified) width and height being submitted and their size being compared to the booked size, trimmed to exact size and waxed. Chew does not specifically disclose the print sheet size per se; however in at least P11-P13 discloses the manual process of finding a suitable placement for every ad with the designated ad pages. Chew in at least P17-P18 discloses the automation of the manual workflow for the automatic placement (layout) of advertisements. Chew in at least P29 discloses the layout of the advertisements is performed in Alexis (Figure 2) for the entire page complete with text, images and graphics ready to be routed to the image-setters for full-page printing. It would have obvious, at the time of the invention to one of ordinary skill to modify the combination of Johari/Chew with the print sheet size with the motivation to allow a print job requester to view their advertisements at the appropriate size.

#### **Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

26 March 2009

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627